

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Robert L. Cook et al.) Group Art Unit: 2625
Serial No.: 10/811,209) Examiner: Saeid Dehhkordy Ebrahimi
Filing Date: March 26, 2004)
Title: Optimizing Raster Operation Functions During Print Job Processing

Mail Stop Amendment
Commissioner for Patents
PO Box 1450
Arlington VA 22313-1450

AMENDMENT TO OFFICE ACTION

In response to the Office Action mailed on May 13, 2009, Applicants respond as follows:

In the outstanding Office Action, claims 1-6 and 8 are subject to another restriction requirement. The Office Action identifies Invention I as being directed to claims 1-6; and Invention II as being directed to claim 8. In response, Applicants elect Invention I, corresponding to claims 1-6, for prosecution in the present application, with traverse.

It is undisputed that in order to impose a restriction, an Examiner must prove that such restriction is warranted. Every requirement to restrict has two aspects: (A) the **reasons** (as distinguished from the mere statement of conclusion) why each invention as claimed is either independent or distinct from the others; and (B) the **reasons why there would be a serious burden** on the Examiner if restriction is not required. MPEP 808 (emphasis added). Examiners **must** provide reasons and/or examples to support conclusions. MPEP 801(l) (emphasis added). A mere statement of conclusion is inadequate. MPEP 808.01. A combination and subcombination are distinct if it can be **shown** that a combination as claimed: A) does not require the particulars of the subcombination as claimed; and B) the subcombination can be shown to have utility by itself or in another materially different combination. MPEP 806.05(c). In presenting the reasons why there would be a serious burden on the Examiner if the restriction is not required, the Examiner **must show by appropriate explanation** one of the following: (A) separate classification thereof; (B) a separate status in the art when the inventions are classified together; and (C) a different field of search. MPEP 808.02 (emphasis added).

Concerning MPEP 808(A)

Inventions I and II are identified in the outstanding Office Action as being related as combination and subcombination. In the Office Action, it is contended that the combination as claimed does not require the particulars of the subcombination as claimed, and the

subcombination has separate utility. First, the Office Action fails to point out which invention is considered the combination and which is considered the subcombination. Applicants submit that it is not Applicants' responsibility to identify which invention is the combination and which invention is the subcombination. Second, there is no showing that the combination (whichever invention is applicable) does not require the particulars of the subcombination as claimed. Merely stating the combination does not require the subcombination's particulars does not amount to a showing as required. No reasons are presented and instead merely statements of conclusion are provided. Based upon the foregoing, Applicants submit that the Office Action fails to meet the requirements under MPEP 808(A).

Concerning MPEP 808(B)

In the outstanding Office Action, there is no reason provided why there would be a serious burden on the Examiner if the restriction is not required. There is no showing of separate classification. In fact, no classifications are even provided. There is no mention of a separate status in the art or of a different field of search being necessary. The Office Action is completely silent as to a burden being on the Examiner. By altogether ignoring the requirement clearly laid out in MPEP 808(B) and MPEP 806.05(c), the Examiner has failed to show a serious burden existing if the restriction is not required.

Due to the insufficiency in showing both that the two inventions are distinct and that there would be a serious burden on the Examiner if a restriction is not required, Applicants respectfully submit that the burden of proof under MPEP 808 has not been met and request that the restriction be withdrawn and all of the pending claims be prosecuted in the present application.

In reply to this present response, if the Examiner wishes to sufficiently prove that the restriction is warranted, the present restriction needs to be withdrawn and a new restriction entered having the necessary proof so as to give Applicants an opportunity to reply. Attempting to provide a level of proof after the fact in a subsequent action that makes the restriction final, without such proof first being in a restriction to which Applicants are able to respond, does not meet the requirements clearly stated under MPEP 808 and thereby renders restriction practice susceptible to arbitrary and capricious findings.

Applicants submit that in light of the foregoing remarks this application is in condition for allowance and early passage of this case to issue is requested. The Examiner is invited to telephone the undersigned in the event the Examiner would like to discuss the merits of the application or this Response.

If there are any other fees not accounted for above, the assignee of present application, Lexmark International Inc., hereby authorizes the Commissioner to charge any such fees, including any extension of time fees, to the account of Lexmark International Inc., Deposit Account No. 12-1213.

Respectfully submitted,

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